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WASHINGTON, D.C. 20231
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Fish & Richardson, P.C.
45 Rockefeller Plaza
Suite 2800
New York, NY 10111

In re Application of : DECISION ON
DESMOTS et al. :
Application No.: 09/381,890 : PETITION UNDER
PCT No.: PCT/GB98/00950 :
Int. Filing Date: 30 March 1998 : 37 CFR 1.47(a)
Priority Date: 09 April 1997 :
Attorney Docket No.: 08291/619001 :
For: DIPALATORY COMPOSITIONS, THEIR :
PREPARATION AND USE :
:

This is a decision on applicants' "RESPONSE TO DECISION ON PETITION" filed in the United States Patent and Trademark Office (USPTO) on 19 March 2001, which has been treated as a petition under 37 CFR 1.47(a).

BACKGROUND

On 30 March 1998, applicants filed international application PCT/GB98/00950, which claimed a priority date of 09 April 1997. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 15 October 1998. A Demand for international preliminary examination, in which the United States was elected, was filed on 04 November 1998, within nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 12 October 1999 (09 October 1999 being a Saturday and 11 October 1999 being a legal public holiday).

On 24 September 1999, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, an unexecuted declaration.

On 02 November 1999, a "Notification of Missing Requirements Under 35 USC 371" (Form PCT/DO/EO/905) was mailed to applicants requiring an oath or declaration in compliance with 37 CFR 1.497(a)-(b) and surcharge fee under 37 CFR 1.492(e). A one month period for reply was set therein.

On 03 April 2000, applicants filed an executed declaration, surcharge fee under 37 CFR 1.492(e), and petition/fee for a four month extension of time. The declaration identified an

inventor's name not appearing in the published international application, i.e., Severine Poette, and failed to identify an inventor's name that does appear therein, i.e., Severine Hemery.

On 04 May 2000, a "Notification of Defective Response" (Form PCT/DO/EO/916) was mailed to applicants indicating that the declaration failed to identify the inventors.

On 05 June 2000, applicants filed a renewed petition indicating that Ms. Hemery's last name was changed to "Poette" as a result of marriage.

On 19 September 2000, a decision was mailed to applicants indicating that the petition under 37 CFR 1.182 regarding the name change of Ms. Hemery was granted. It was also noted, however, that the executed declaration filed 03 April 2000 failed to comply with 37 CFR 1.497(a). The decision stated that a new oath or declaration in compliance with 37 CFR 1.497(a)-(b) was required. A one month extendable time period was set.

On 19 March 2001, applicants submitted the instant "RESPONSE TO DECISION ON PETITION". The submission was accompanied by: declarations of inventors from each of David Acher, Gerd Dahms, Bruno Guillaume, and Severine Poette; a petition under 37 CFR 1.47(a) including declarations by Amanda J. Wilde; and a petition/fee for a five month extension of time.

On 23 April 2001, applicants submitted a "REQUEST FOR REFUND" requesting that the fees in the amount of \$130.00 and \$1,760.00 charged to Deposit Account No. 06-1050 be refunded as these fees were submitted by check on 19 March 2001.

DISCUSSION

Although the instant petition is entitled by applicants as a petition under 37 CFR 1.47(b), it is treated as a petition under 37 CFR 1.47(a) since the instant situation is one where several of the joint inventors refuse to join in an application or cannot be found or reached after diligent effort rather than a situation where all of the inventors refuse to execute an application or cannot be found or reached after diligent effort.

37 CFR 1.497(a)-(b)

It is noted that the declarations of inventors accompanying the petition under 37 CFR 1.47(a) filed 19 March 2001 do not comply with 37 CFR 1.497(a)-(b). Each executed declaration must identify each inventor. The declarations accompanying the petition under 37 CFR 1.47(a) filed 19 March 2001 fail to identify each inventor. Rather, each declaration identifies only one inventor. Consequently, a new oath(s) or declaration(s) properly identifying all of the inventors and signed by all of the inventors, with the exception of any unavailable inventors under 37 CFR 1.47, is required.

Petition Under 37 CFR 1.47(a)

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

As to (1), the fee of \$130.00 has been paid.

As to (3), a statement of the last known addresses of Annick Canelas, Sarah Desmots, Hubert Delagneau, and Philippe Ledon has been provided.

As to (2), it is noted that applicants failed to show or provide proof that a copy of the application papers (specification, including claims, drawings, and oath or declaration) were presented to the non-signing inventors. The copies of the letters mailed to the non-signing joint inventors requesting that they sign a declaration of inventors suggest that only a declaration was sent to these inventors.

Moreover, it is not clear whether it is being alleged that the nonsigning inventors refuse to execute the application or that they cannot be reached after diligent effort. Note that it is not clear that any of these mailings were received by the inventors (with the exception of the first mailing to Sarah Desmots which is indicated as having been returned). However, it is not clear whether the second mailing to Ms. Desmots was received by her.). There is no suggestion or evidence that any type of means to verify receipt was used. Thus, it is not clear if the mailings were undelivered or lost, if the inventors are no longer at these addresses and their whereabouts are unknown, or if they simply received the mailings and did not respond. If the mailings were received and the inventors did not respond, then a refusal to execute the application would likely need to be established. See MPEP § 409.03(d). If it is being alleged that these inventors cannot be reached or found, copies of documentary evidence such as certified mail return receipt that support a finding that the nonsigning inventors could not be found or reached should be made part of the affidavit or declaration.

As to (4), it is not clear that each 37 CFR 1.47(a) applicant has signed on behalf of the non-signing joint inventors since the declarations which have been executed do not list the non-signing joint inventors. As noted above, each executed declaration must identify each inventor. Thus, applicants have not met item (4).

Accordingly, it is not appropriate to accord the national stage application status under 37 CFR 1.47(a) at this time.

Refund

On 23 April 2001, applicants submitted a "REQUEST FOR REFUND" requesting that the fees in the amount of \$130.00 and \$1,760.00 charged to Deposit Account No. 06-1050 be refunded as these fees were submitted by check on 19 March 2001. It is noted that the check for \$1,890.00 (check number 119497) submitted on 19 March 2001 was inadvertently not processed by the USPTO. The unprocessed check has been marked VOID and is enclosed with this decision.

CONCLUSION

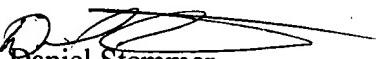
For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required.

A new oath(s) or declaration(s) properly identifying all of the inventors and signed by all of the inventors, with the exception of any unavailable inventors under 37 CFR 1.47, is required within TWO (2) MONTHS of the mail date of this decision.

Failure to timely file the proper response will result in **ABANDONMENT** of this application.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of this letter marked to the attention of the Office of PCT Legal Administration.



Daniel Stemmer

PCT Legal Examiner

PCT Legal Affairs

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Legal Administration

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Enclosure: Check No. 119497 to "COMMISSIONER OF PATENTS AND TRADEMARKS" for \$1,890.00 dated 19 March 2001 which has been marked VOID

FR FISH & RICHARDSON P.C.

125 Franklin Street
Boston, Massachusetts
02110-2804

c 119497

PAY One thousand eight hundred ninety and no/100 DOLLARS

TO THE ORDER OF	DATE	AMOUNT
COMMISSIONER OF PATENTS AND TRADEMARKS	3-19-01	1890.00

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